

REMARKS

Claims 39-41 are now allowed.

Claims 1-24 and 42-43 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention. Claims 25-27, 29, 31-41, 44-50 and 53 are currently pending in the application. Reconsideration of the outstanding rejections is requested for the reasons that follow.

Claim Amendments

Without conceding to the Examiner's positions and solely in the interest of expediting prosecution, the following claim amendments have been made. However, Applicants reserve the right to re-introduce any amended/deleted subject matter at any time during the proceedings and/or in one or more continuation or divisional applications.

Claims 33 and 37 have been amended to recite "full-length coding sequence of the cDNA transcript flanked by the two adapters from step (i)" as indicated. It is respectfully submitted that this amendment has been made to clarify the language of the claim and does not extend beyond the written description of the application as filed. No new matter has been added as a result of these amendments.

Rejections under 35 USC § 112, first paragraph

The Examiner has rejected claims 25-27, 29, 31-38, 44-50 and 53 under 35 USC § 112, first paragraph, as failing to comply with the written description rejection.

Specifically, the Examiner argues that the prior claim amendments of producing and cleaving the “at least one full-length coding sequence of a cDNA transcript” lacks written description support. The Examiner argues further that the specification does disclose full-length genes and full-length cDNAs, but not producing/ cleaving a full-length coding sequence of a cDNA transcript. Applicants traverse.

As acknowledged by the Examiner, para. 14 of the published specification discloses that the nucleic acid molecule “may be the full-length sequence of a gene...,” citing as examples “full-length cDNA...” The Examiner further acknowledges that the specification reviews many similar disclosures of full length genes (e.g., paras. 14, 44, 48) and full-length cDNA (paras. 14, 52, 53, 56, 58, 90 etc.) Accordingly, Applicants note that the Examiner concedes that there is written description support for the “full-length cDNA transcript” limitation.

At least Figures 1 and 2 of the specification as filed show the preparation of a “full-length cDNA transcript” from mRNA. One of skill in the art would have known at the time of filing the present application that this mRNA has a coding region and consequently, full-length cDNA reverse transcribed from this mRNA inherently has a corresponding coding sequence. Further, because the cDNA transcript is full-length, the coding sequence contained therein also must be inherently “full-length.”

Further, the specification teaches that the paired 5' and 3' tags “delineate the starting and ending points of transcripts” (para. 47). Thus, because the transcripts encompass the starting and ending points, it follows that they must be full-length and the coding region contained therein must also be full-length. Accordingly, it is

respectfully submitted that “full-length coding sequence of a cDNA transcript” has at least inherent written description support based on the disclosure in the specification and the knowledge of one of skill in the art at the time of the filing of the present application. Consequently, the rejection should be withdrawn.

Rejections under 35 USC § 112, second paragraph

The Examiner has rejected claims 33-37 under 35 USC § 112, second paragraph, as allegedly being indefinite. Specifically, the Examiner argues that the limitation in claim 33 of “the full-length cDNA transcript from step (i)” is indefinite because of the immediately prior amendment to claim 26. Claims 34-36 are rejected because they depend from claim 33. The Examiner has rejected claim 37 for the same reason.

It is respectfully submitted that with the amendments to independent claims 33 and 37, discussed above, there is now antecedent basis for the terms “full-length coding sequence of the cDNA transcript flanked by the two adapters from step (i).” Accordingly, the rejection should be withdrawn.

In view of the above, Applicants respectfully submit that the claims under examination are in condition for allowance.

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Respectfully submitted,

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